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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,006	12/11/2001	Karunasena A. Alahapperuma	55571US009	4641

7590 10/09/2003

Office of Intellectual Property Counsel
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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 7/16/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 0612
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The use of the trademark MEOCRYL CX-100 previously set forth in paragraph No. 1 of Paper No. 3 is again noted in this application as failing to contain suitable generic terminology of its composition. Applicants have traversed this objection, but their response is not seen to address the merits of the Examiner's position and accordingly it is hereby repeated.

3. Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, the Examiner repeats his rejection set forth in paragraph No. 3 of Paper No. 3 that it is confusing to use both "wt%" and "parts" without further identification in the same claim. The fact that each type of terminology has been often utilized in the chemical arts is simply irrelevant to the issue as presented by the Examiner.

4. Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishiwata et al. -473 (Ishiwata et al. -242 is again cumulative), substantially for the reasons set forth in paragraph No. 7 of Paper No. 3, together with the following additional observations. Applicants argue (Response, page 6, first paragraph) that the Examiner has provided no evidence that such free radical initiators as claimed by

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applicants are well known to one of ordinary skill in the art. Accordingly, the Examiner notes that EP 0981156A2, cited as evidence of the state of the art, discloses (e.g. Example 4 at paragraph (0064) at page 7) a very closely related adhesive composition to that claimed by applicants, lacking only a different range of proportions of the various ingredients, and clearly teaches the utilization of the thermally stable free radical polymerization initiator IRGACURE 184, taught by applicants' specification at page 13, line 2 as being one of their most preferred initiators, as particularly suitable in their radiation curable pressure sensitive adhesive composition. Accordingly, it is respectfully submitted that the Examiner has clearly met his burden of disclosing that such thermally stable free radical initiators are well known in the acrylic radiation detachifiable adhesive composition art.

Additionally, the Examiner further notes applicants' contention (Response, page 6, second paragraph) that Ishiwata et al. -473's teaching of the claimed range of proportions at column 8, lines 1-3 "appears in contradiction" to various other teachings of the reference. However, there is no question that the reference clearly and unambiguously teaches this particular range of proportions which reads upon applicants' claimed range, and accordingly whether or not it is correct does not negate the fact that it is clearly set forth as an enabling teaching in the

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reference. Additionally, it is further believed that such parameters are obvious optimizations to one of ordinary skill.

5. Claims 1-16 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,472,065B1, substantially for the reasons set forth in paragraph No. 9 of Paper No. 3, together with the following additional observations. Applicants argue essentially only what they have argued in the previous paragraph, i.e. that a selection of a suitable thermally stable free radical initiator is not within the skill of the art as the Examiner contends. However, as was set forth above, the aforementioned teachings of EP -156 as cited evidence of the state of the art regarding photopolymerization initiators are believed to clearly overcome applicants' position.

6. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION

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IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 6, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zirker